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10/772,277	02/06/2004	Akira Nomiya	500.43493X00	2187

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EXAMINER

MORRISON, THOMAS A

ART UNIT PAPER NUMBER

3653

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/772,277		NOMIYAMA ET AL.	
	Examiner		Art Unit	
	Thomas A. Morrison		3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-17 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/6/04, 10/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 6, 7, 18/7/5/1, 18/6/5/1, 19/7/5/1, 19/6/5/1, 20/7/5/1 and 20/6/5/1.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species III- Fig. 20 (i.e., claims 1-5 and 8-20) in the reply filed on 11/27/2006 is acknowledged. The traversal is on the ground(s) that currently at least claim 1 appears to be generic. Also, applicants argue that claim 1 has not been rejected, and therefore, applicants submit that claim 1 is allowable, and the requirement for election of a single species should be withdrawn. This is not found persuasive because claim 1 had not been examined at the time the restriction requirement was made. Now that claim 1 has been examined, it has been determined that claim 1 is not allowable, as outlined in the rejections below. Accordingly, claim 1 is not an allowable generic claim. Claims 6, 7, 18/7/5/1, 18/6/5/1, 19/7/5/1, 19/6/5/1, 20/7/5/1 and 20/6/5/1 have been withdrawn from further consideration as being drawn to a non-elected embodiment.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claims 18-20 are objected to under 37 CFR 1.75(c) as being in improper form because multiple dependent claims 18 and 19 depend from other multiple dependent claims 9-11. Also, the multiple dependent claim 20 depends from several other multiple dependent claims 9-11, 18 and 19. See MPEP § 608.01(n). Accordingly, the claims 18-20 have not been further treated on the merits.

Also, claim 1 is objected to for the following informalities: (1) "characterized by" in line 2 of claim 1 should be -- comprising: --.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-3, 9/1, 10/1, 11/1, 12-13 and 15 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: (1) the structural relationship between the travel regulating means and the other elements set forth in claim 2, which allows the travel regulating means to cause a leading end of a paper money to impinge thereupon; and (2) the structure in claim 2 that changes a position of the travel regulating means.

Regarding claim 2, it is unclear if the recited "a size of the paper money" is the same or different from the previously recited "a size of a paper money" in claim 1.

Claim 3 recites the limitation "the position" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the leading end" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 9/1 recites the limitation "the interference preventing means" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

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Claim 10/1 recites the limitation "the interference preventing means" in lines 4-5.

There is insufficient antecedent basis for this limitation in the claim.

Claim 11/1 recites the limitation "the interference preventing means" in line 4.

There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 12, it is unclear what is meant by the recited "a paper money **enterance** preventing means". (emphasis added).

Claim 13 recites "a separating and accumulating guide for guiding stacked paper money which has been introduced". It is unclear where the paper money has been introduced.

Claim 13 recites the limitation "the separating and stacking guide " in lines 5-6.

There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the stacking and separating means" in line 4.

There is insufficient antecedent basis for this limitation in the claim.

The above indefiniteness problems are merely examples. Applicant should review all of the claims and correct any indefiniteness problems with the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5 and 8-17, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2003/0127509.

Regarding claim 1, Figs. 1-23 show a paper money receiving and paying apparatus (Fig. 1) characterized by a stacking and separating device (8) for stacking and separating paper moneys,

a paper money size detecting means (numbered paragraph [0093]) for detecting sizes of paper moneys stacked in the stacking and separating device (8), and

a travel regulating means (including 812) for regulating a travel of a paper money in the stacking and separating device (8), and

a control part (numbered paragraph [0075]) for controlling the travel regulating means (including 812) in accordance with a size of a paper money.

Regarding claim 2, Figs. 20A-20D and numbered paragraph [0097] disclose that the travel regulating means (including 812) causes a leading end of a paper money to impinge thereupon, and a position of the travel regulating means (including 812) is changed in accordance with a size of the paper money.

Regarding claim 3, Figs. 20A-20D show that the travel regulating means (including 812) is adapted to rotate so as to change the position where the leading end of a paper money impinges thereupon.

Regarding claim 4, Fig. 19 shows that an external shape of the travel regulating means (including 812) is arcuated in a part thereof, or in its entirety.

Regarding claim 5, numbered paragraphs [0017] and [0090] disclose an interference preventing means for preventing paper moneys after accumulation thereof from entering into a space for accumulating paper moneys.

Regarding claim 8, the numbered paragraphs [0018] and [0090] disclose that the travel regulating means (including 812) and the interference preventing means are integrally incorporated with each other.

Regarding claim 9, numbered paragraphs [0087]-[0089] disclose that the travel regulating means (including 812) and the interference preventing means can be retracted so as to prevent interference with stacked paper moneys.

Regarding claim 10, numbered paragraph [0082] disclose that a friction reducing member is incorporated in the travel regulating means (including 812).

Regarding claim 11, numbered paragraphs [0016] and [0085] disclose that there are provided the travel regulating means (including 812) in a plural number.

Regarding claim 12, Figs. 19-20D show that the travel regulating means (including 812) includes paper money entrance preventing means for preventing stacked paper moneys from being caught.

Regarding claim 13, Figs. 20b-20c show that the stacking and separating device incorporates a separating and accumulating guide for guiding stacked paper money which has been introduced, and the separating and stacking guide has an end part which is curved. See Figs. 20b-20c for the guide that guides sheets into the device.

Regarding claim 14, numbered paragraph [0093] discloses that the paper money size detecting means comprises a paper money determining part for determining a denomination of a paper money, and a memory part incorporating a data base in which denominations and sizes of paper moneys are assigned to each other.

Regarding claim 15, numbered paragraphs [0093]-[0095] disclose a paper money detecting means for detecting a paper money conveyed to the stacking and separating means (8), and the travel regulating means (including 812) is controlled through the detection of a paper money by the paper money detecting means.

Regarding claim 16, numbered paragraphs [0086]-[0087] and Fig. 17 disclose a stacking space volume detecting means for detecting an occupying value of stacked paper moneys which occupy a space for stacking paper moneys within the stacking and

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separating device (8), and the travel regulating means (including 812) is controlled in accordance with a result of detection by the stacking space volume detecting means.

Regarding claim 17, see numbered paragraph [0010] and Fig. 17 disclose that the stacking and separating device (8) stacks paper in a standing posture.

5. Claims 1-5 and 8-17, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Publication No. 2003/0127509. In particular, this reference discloses all of the limitations of claims 1-5 and 8-17. Note: the comparison between the elements of claims 1-5 and 8-17 and the elements of U.S. Patent Publication No. 2003/0127509 is the same as the comparison outlined above in the rejection under 35 U.S.C. 102(e).

6. Claims 1-5, 8-11 and 13-15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by International Application Publication No. WO00/24662 (cited in the 10/19/04 IDS).

Regarding claim 1, Figs. 1-5 show a paper money receiving and paying apparatus characterized by a stacking and separating device (Fig. 1) for stacking and separating paper moneys,

a paper money size detecting means (e.g., page 3, lines 5-8 and page 7, line 34 to page 8, line 22) for detecting sizes of paper moneys stacked in the stacking and separating device (Fig. 1), and

a travel regulating means (including 21 and 20) for regulating a travel of a paper money in the stacking and separating device (Fig. 1), and

a control part (including 11) for controlling the travel regulating means (including 21 and 20) in accordance with a size of a paper money (see e.g., page 8, lines 14-22).

Regarding claim 2, page 5, lines 27-28 and page 3, lines 25-27 disclose that the travel regulating means (including 21 and 20) causes a leading end of a paper money to impinge thereupon, and a position of the travel regulating means (including 21 and 20) is changed in accordance with a size of the paper money.

Regarding claim 3, Fig. 2 shows that the travel regulating means (including 21 and 20) is adapted to rotate so as to change the position where the leading end of a paper money impinges thereupon. Element 20 rotates, as claimed.

Regarding claim 4, Fig. 2 shows that an external shape of the travel regulating means (including 20 and 21) is arcuated in a part thereof, or in its entirety. See e.g., arcuate cutout in element 21, as shown in Fig. 2.

Regarding claim 5, Figs. 1-2 show an interference preventing means (5 or 6) for preventing paper moneys after accumulation thereof from entering into a space for accumulating paper moneys.

Regarding claim 8, Fig. 2 shows that the travel regulating means (including 21 and 20) and the interference preventing means (5) are integrally incorporated with each other.

Regarding claim 9, Figs. 1-5 show that the travel regulating means (including 21 and 20) and the interference preventing means (6) can be retracted so as to prevent interference with stacked paper moneys.

Regarding claim 10, page 8, lines 14-22 disclose that a friction reducing member is incorporated in the travel regulating means (including 21 and 20). The mechanism that adjusts the travel regulating means to the correct size for a bill results in reducing friction on the bill that is supplied thereto. Such mechanism acts as a friction reducing member, as claimed.

Regarding claim 11, Fig. 1 shows that there are provided the interference preventing means (6) in a plural number.

Regarding claim 13, Figs. 1-2 show that the stacking and separating device (Fig. 1) incorporates a separating and accumulating guide (5) for guiding stacked paper money which has been introduced, and the separating and stacking guide (5) has an end part which is curved.

Regarding claim 14, page 7, line 34 to page 8, line 22 discloses that the paper money size detecting means comprises a paper money determining part for determining a denomination of a paper money, and a memory part incorporating a data base in which denominations and sizes of paper moneys are assigned to each other.

Regarding claim 15, Fig. 2, page 5, line 35 to page 6, line 2, and page 7, line 34 to page 8, line 22 disclose a paper money detecting means for detecting a paper money conveyed to the stacking and separating means (Fig. 1), and the travel regulating

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means (including 21 and 20) is controlled through the detection of a paper money by the paper money detecting means.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,889,897 (Nomiya et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the Nomiya et al. patent includes all of the limitations set forth in claim 1 of the instant application. Note: the recited travel regulating means in claim 1 of the instant application is equivalent to the recited a stacking assist means set forth in claim 1 of the Nomiya et al. patent.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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